UNITED STATES PATENT AND TRADEMARK OFFICE

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09/893,647	06/29/2001	Haruhisa Suzuki	35.C15500	5810

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *37 and 38* is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) ☐ Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____.	6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9, 11-17, 19, 21-23, 25-27, 29-30, 32-33, & 35-36 are rejected under 35

U.S.C. 102(e) as being anticipated by Gase (US 6,184,996).

Regarding claim 1, Gase teaches a print system **(fig 1)** in which a server **(fig 1, client 10 with**

server procedure 20) and a printer **(fig 1, printer 14)** are connected to a network, comprising:

input means for inputting a print instruction in which first position information has been

designated **(column 3:lines 12-23 & lines 4-9, printer 14 receives position information, i.e.**

URL from client 12 instructing a print job to be printed, which inherently requires an input

means to input the print job instruction from the client 12);

extracting means for extracting second position information from said first position information

(column 3:lines 6-9 & 16-21, when the client 12 sends a URL to the printer 14, i.e. the first

position information, the printer 14 implements the browser procedure 26, i.e. the

requesting means, and uses the URL received from client 12 to request a print job at client

10 with server procedure 20.   Client 10 with server procedure 20 inherently receives the

URL and extracts a local reference to the print job's position from the URL, i.e. extracts the

second position information from the first position information, otherwise the client 10

with server procedure 20 could not access the requested print job, therefore an extracting means is inherent in the client 10 with server procedure 20);

forming means for forming print data on the basis of said second position information (column 3:lines 16-21, the printer 14 receives print job 23 from client 10 with server procedure 20, which inherently includes a forming means on the client 10 with server procedure 20 that forms the data based on the second position information, otherwise that data could not be transferred if it could not already be formed);

and printing means for printing on the basis of said print data (column 3:lines 6-9, printer 14 accepts print job 23 from client 10 with server procedure 20 for printing, which inherently requires a printing means).

Regarding claim 2, Gase teaches a system according to claim 1, wherein said input means and said printing means are included in said printer (column 3:lines 4-9, printer receives URL from client, inherently requiring an input means. Printer 14 accepts print job 23 from client 10 with server procedure 20 for printing, which inherently requires a printing means), and said extracting means and said forming means are included in said server (column 3:lines 6-9 & 16-21, Client 10 with server procedure 20 inherently receives the URL and extracts a local reference to the print job's position from the URL, i.e. extracts the second position information from the first position information, otherwise the client 10 with server procedure 20 could not access the requested print job, therefore an extracting means is inherent in the client 10 with server procedure 20. The printer 14 receives print job 23 from client 10 with server procedure 20, which inherently includes a forming means on the client 10 with server procedure 20 that forms the data based on the second position information, otherwise that data could not be transferred if it could not already be formed).

Regarding claim 3, Gase teaches a system according to claim 1, further comprising instructing means for instructing said print instruction (column 3:lines 6-9 & 16-21, client 12 instructs

printer 14 to print a print job 23, which inherently requires an instructing means in the
client 12).

Regarding claim 4, Gase teaches a system according to claim 3, wherein an information
appliance **(fig 1, client 12)** is further connected to said network, said instructing means is
included in said information appliance **(column 3:lines 6-9 & 16-21, client 12 instructs printer
14 to print a print job 23, which inherently requires an instructing means in the client 12),**
said input means and said printing means are included in said printer **(column 3:lines 4-9,
printer receives URL from client, inherently requiring an input means. Printer 14 accepts
print job 23 from client 10 with server procedure 20 for printing, which inherently requires
a printing means),** and said extracting means and said forming means are included in said
server **(column 3:lines 6-9 & 16-21, Client 10 with server procedure 20 inherently receives
the URL and extracts a local reference to the print job's position from the URL, i.e. extracts
the second position information from the first position information, otherwise the client 10
with server procedure 20 could not access the requested print job, therefore an extracting
means is inherent in the client 10 with server procedure 20. The printer 14 receives print
job 23 from client 10 with server procedure 20, which inherently includes a forming means
on the client 10 with server procedure 20 that forms the data based on the second position
information, otherwise that data could not be transferred if it could not already be formed).**

Regarding claim 5, Gase teaches a system according to claim 3, further comprising requesting
means **(fig 1, browser procedure 26)** for issuing a print request in which said first position
information has been designated in accordance with the instruction by said instructing means
**(column 3:lines 16-21, the printer 14 uses the browser procedure 26, i.e. the requesting
means, to issue a request for the print job using the URL, i.e. the first position
information),** and wherein said extracting means extracts said second position information in
accordance with the request by said requesting means **(column 3:lines 6-9 & 16-21, when the
client 12 sends a URL to the printer 14, i.e. the first position information, the printer 14**

implements the browser procedure 26, i.e. the requesting means, and uses the URL

received from client 12 to request a print job at client 10 with server procedure 20.   Client

10 with server procedure 20 inherently receives the URL and extracts a local reference to

the print job's position from the URL, i.e. extracts the second position information from

the first position information, otherwise the client 10 with server procedure 20 could not

access the requested print job, therefore an extracting means is inherent in the client 10

with server procedure 20).

Regarding claim 6, Gase teaches a system according to claim 5, wherein said instructing means

is included in said information appliance **(column 3:lines 6-9 & 16-21, client 12 instructs**

printer 14 to print a print job 23, which inherently requires an instructing means in the

client 12), and said printing means and said requesting means are included in said printer

(column 3:lines 4-9, printer 14 accepts print job 23 from client 10 with server procedure 20

for printing, which inherently requires a printing means. Fig 1, browser procedure 26, i.e.

the requesting means is a part of the printer 14), and said extracting means and said forming

means are included in said server **(column 3:lines 6-9 & 16-21, Client 10 with server**

procedure 20 inherently receives the URL and extracts a local reference to the print job's

position from the URL, i.e. extracts the second position information from the first position

information, otherwise the client 10 with server procedure 20 could not access the

requested print job, therefore an extracting means is inherent in the client 10 with server

procedure 20. The printer 14 receives print job 23 from client 10 with server procedure 20,

which inherently includes a forming means on the client 10 with server procedure 20 that

forms the data based on the second position information, otherwise that data could not be

transferred if it could not already be formed)

Regarding claim 7, Gase teaches a system according to claim 1, further comprising notifying

means for notifying an end of printing after the end of the printing by said printing means **(column**

3:lines 52-62, client 12 receives a job list from job queue 28 that indicates the print job as complete or not).

Regarding claim 9, Gase teaches a system according to claim 5, further comprising storing means for storing said print request accordance with the instruction by said instructing means (column 3:lines 16-21, the printer 14 uses the browser procedure 26, i.e. the requesting means, to issue a request for the print job using the URL, i.e. the first position information. When client 10 with server procedure 20, i.e. the server, receives the request, it inherently stores the request in memory to process the request).

Claims 11-17, & 19 recite identical features as claims 1-7, & 9 except claims 11-17, & 19 are method claims. Thus, arguments similar to that presented above for claims 1-7, & 9 are equally applicable to claims 11-17, & 19.

Regarding claim 21, Gase teaches a server (fig 1, client 10 with server procedure 20) comprising:

extracting means for extracting second position information from first position information included in a print request which is inputted;(column 3:lines 6-9 & 16-21, when the client 12 sends a URL to the printer 14, i.e. the first position information, the printer 14 implements the browser procedure 26, i.e. the requesting means, and uses the URL received from client 12 to request a print job at client 10 with server procedure 20. Client 10 with server procedure 20 inherently receives the URL and extracts a local reference to the print job's position from the URL, i.e. extracts the second position information from the first position information, otherwise the client 10 with server procedure 20 could not access the requested print job, therefore an extracting means is inherent in the client 10 with server procedure 20);

forming means for forming print data on the basis of said second position information (column 3:lines 16-21, the printer 14 receives print job 23 from client 10 with server procedure 20,

which inherently includes a forming means on the client 10 with server procedure 20 that

forms the data based on the second position information, otherwise that data could not be

transferred if it could not already be formed);

and means for transferring the print data formed by said forming means to a printer (**column

3:lines 16-21, printer 14 accesses the print job from the server 10, which inherently

requires the server 10 to have transferring means for transferring the data to printer 14**).

Regarding claim 22, Gase teaches a server according to claim 21, wherein said printer outputs

said print request in accordance with a print instruction from an information appliance (**column

3:lines 6-9 & 16-21, printer 14 receives URL from client 12, i.e. information appliance, and

requests a print job from server 10 based on that URL**).

Regarding claim 23, Gase teaches a server according to claim 21, further comprising storing

means for storing said print request (**column 3:lines 16-21, the printer 14 uses the browser

procedure 26, i.e. the requesting means, to issue a request for the print job using the URL,

i.e. the first position information. When client 10 with server procedure 20, i.e. the server,

receives the request, it inherently stores the request in memory to process the request**).

Claims 25-27 recite identical features as claims 21-23 except claims 25-27 are method claims.

Thus, arguments similar to that presented above for claims 21-23 are equally applicable to claims

25-27.

Regarding claims 29 & 30, Gase teaches a printing program (**column 4:line 65-column 5:line 9,

software procedures**) comprising the steps representative of method claims 25 & 26.

Regarding claims 32 & 33, Gase teaches a memory medium which stores a program

representative in program claims 29 & 30 (**column 5:lines 1-4, memory disk 80**).

Regarding claim 35, Gase teaches a printer **(fig 1, printer 14)** to which an information appliance

(fig 1, client 12) and a server **(fig 1, client 10 with server procedure)** are connected,

comprising:

 means for receiving a print instruction from said information appliance **(column 3:lines 12-23 &**

lines 4-9, printer 14 receives position information, i.e. URL from client 12 instructing a print

job to be printed, which inherently requires a receiving means to receive the print job

instruction from the client 12);

 means for issuing a print request **(fig 1, browser procedure 26)** to said server **(fig 1, client 10**

with server procedure 20) in response to the print instruction from said information appliance

(fig 1, client 12);

 requesting means for issuing a print request in which said first position information has been

designated in accordance with the instruction by said instructing means **(column 3:lines 16-21,**

the printer 14 uses the browser procedure 26, i.e. the requesting means, to issue a request

for the print job using the URL from the print instruction)

 and means for receiving print data formed by said server in response to said print request

(column 3:lines 6-9, printer 14 accepts print job 23 from server 10 for printing, which

inherently requires a receiving means).

Claim 36 recites identical features as claim 35 except claim 36 is a method claim. Thus,

arguments similar to that presented above for claim 35 is equally applicable to claim 36.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

**Claims 8, 10, 24, 28, 31, & 34 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Gase (US 6,184,996) & Buckley et al. (US 6,798,530).**

Regarding claim 8, Gase teaches a system according to claim 1 including a client 12 with an
inherent detecting means that detects printers (in this case printer 14), otherwise the client could
not use the printer if it could not originally detect it. Gase does not teach a detecting means for
detecting multiple printers nor does he teach a selecting means for selecting one of the printers
detected by said detecting means.

However, Buckley et al., teaches a client 100 connected to printers 300 and 310 **(column
5:lines 31-36)**, which inherently requires a detecting means to detect the printers, otherwise the
client could not connect to the printers if it could not originally detect it. Futhermore, Buckley et
al., teaches a selecting means for selecting one of the printers **(fig 6, graphical user interface
(GUI) 700 allows for the selection of any printer that has been detected)**.

Accordingly, it would have been obvious to one skilled in the art to have used the the
detecting means and the selecting means for multiple printers as taught by Buckley et al., in the
system taught by Gase because it expands the printer selection of the client, allowing it to route a
job to the best printer, especially since the client in the Gase system can access the print job
queue and predict the wait time based on the number of jobs in the queue.

Regarding claim 10, Gase teaches a system according to claim 1, but does not teach a system
further comprising an obtaining means for obtaining information regarding said printer; and a
dividing means for dividing said print data on the basis of the information obtained by said
obtaining means.

However, Buckley et al., teaches a system with an obtaining means **(fig 2, printer
definition memory portion 132)** for obtaining information regarding said printer **(column 6:lines
48-50, the memory portion 132 obtains printer definitions, including rendering parameter
options)**. Buckley et al., further teaches a dividing means **(fig 6, graphical user interface (GUI)
700)** for dividing said print data on the basis of the information obtained by said obtaining means

(fig 6, teaches GUI 700 that separates the object types, i.e. the print data, on the basis of printer capabilities).

Accordingly, it would have been obvious to one skilled in the art to have used the obtaining means and the dividing means taught by Buckley et al., in the system taught by Gase because it expands the printer selection of the client and server, allowing either one to route a job to the best printer, especially since the client or server in the Gase system can access the print job queue and the user can predict the wait time based on the number of jobs in the queue. Futhermore, the object type division as taught by Buckley et al., provides the user the ability to select the best printer for a particular part of the document.

Regarding claim 24, Gase teaches a server according to claim 21, but does not teach a server further comprising an obtaining means for obtaining information regarding said printer; and a dividing means for dividing said print data on the basis of the information obtained by said obtaining means.

However, Buckley et al., teach a system with an obtaining means **(fig 2, printer definition memory portion 132)** for obtaining information regarding said printer **(column 6:lines 48-50, the memory portion 132 obtains printer definitions, including rendering parameter options)**. Buckley et al., further teach a dividing means **(fig 6, graphical user interface (GUI) 700)** for dividing said print data on the basis of the information obtained by said obtaining means **(fig 6, teaches GUI 700 that separates the object types, i.e. the print data, on the basis of printer capabilities)**. Buckley et al., teach a client computer 100 with obtaining and dividing means **(column 5:lines 26-28)** that can be applied to the Gase teachings that include a client 10 acting as a server. The graphical user interface supplied by the Buckley et al., teachings can then be manipulated by a user on the client 10 acting as a server.

Accordingly, it would have been obvious to one skilled in the art to have used the obtaining means and the dividing means taught by Buckley et al., in the system taught by Gase because it expands the printer selection of the client and server, allowing either one to route a job to the best printer, especially since the client or server in the Gase system can access the print

job queue and the user can predict the wait time based on the number of jobs in the queue. Futhermore, the object type division as taught by Buckley et al., provides the user the ability to select the best printer for a particular part of the document.

Claim 28 recites identical features as claim 24 except claim 28 is a method claim. Thus, arguments similar to that presented above for claim 24 are equally applicable to claim 28.

Regarding claim 31, Gase teaches a printing program **(column 4:line 65-column 5:line 9, software procedures)** comprising the steps representative of method claim 28.

Regarding claim 34, Gase teaches a memory medium which stores a program representative in program claim 31 **(column 5:lines 1-4, memory disk 80)**.

Allowable Subject Matter

Claims 37-36 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The invention is directed to a printer, server, & client apparatus system wherein the client apparatus informs the printer of a document to be printed via location information in a print instruction, and the printer then sends a request to a server to retrieve and send the print data. The invention is more specifically directed to an additional characteristic in the system that allows the printer, when unable to make a connection with a server, to send the print request directly to the client apparatus. The following applications disclose similar art. The closest prior art, Gase (US 6,184,996), discloses a similar system wherein the client apparatus informs the printer of a document to be printed via location information in a print instruction, and the printer then sends a request to a server to retrieve and send the print data. Gase does not, however, disclose a printer request to a client apparatus in the case a server connection cannot be made. Aoki (US 6,369,907) discloses a similar system wherein a PC sends a print request and print data to a

printer, and the printer sends a request to a server to process the data and return it to the printer for printing. · Aoki does not, however, disclose disclose a printer request to a client apparatus in the case a server connection cannot be made because the print data has already been sent along with the original request to the printer. Nakatsuma et al. (US 6,115,132) discloses similar art to the invention, wherein a client apparatus transmits a print instruction to a server (not a printer), and if its print data is determined printable, the client apparatus sends the print data directly to the printer. Nakatsuma et al. do not, however, disclose the sending of an instruction to a printer and the sending of a request to a server from the printer.
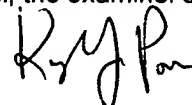
Regarding claims 37 & 38, Gase does not teach a print system or method for the print system comprising:

an information appliance for instructing printing;

a printer for issuing a print request in response to said print instruction from said information appliance;

a server for transferring print data to said printer in accordance with the print request from said printer;

and discriminating means for discriminating whether said printer can be connected to said server or not, wherein when it is determined by said discriminating means that said printer cannot be connected, said printer issues said print request to said information appliance.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Pendergrass whose telephone number is **(571) 272-7438**. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440.

**KING Y. POON
PRIMARY EXAMINER**